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10/083,717	02/25/2002	Lin-Feng Li	eVionyx-0015USAAON00	3959
26665	7590	08/24/2004	EXAMINER	
REVEO, INC. 85 EXECUTIVE BOULEVARD ELMSFORD, NY 10523			CANTELMO, GREGG	
			ART UNIT	PAPER NUMBER

1745

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Response to Amendment

1. In response to the amendment received June 14, 2004:
 - a. Claims 2, 3, 21 and 22 have been cancelled. Claims 1, 4-20 and 23-25 are pending;
 - b. The prior art rejections of JP '866 stand;
 - c. All other prior art rejections of record are withdrawn in light of the amendment.

Election/Restrictions

2. Newly submitted claims 23-25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Amended claim 1 and newly presented claims 23-25 are held to be patentably distinct species. For example the electrode of claim 1 does not require the fiber distribution of characteristics lengths. Alternatively the electrode claim 23 is not limited to the particular electrically conductive materials of claim 1. Therefore because these inventions are deemed to be distinct species and the search for each of these claims are not coextensive in scope, restriction of new claims 23-25 is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Information Disclosure Statement

3. The information disclosure statement filed May 10, 2004 has been placed in the application file and the information referred to therein has been considered as to the merits.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-8, 13-14 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 58-019866-A (JP '866).

JP '866 discloses an electrode comprising iron fibers coated with nickel and a cadmium metal active material. The conductive material includes the iron fibers and the cadmium metal active material (abstract as applied to claim 1).

The diameter of the fibers is 4-100 micrometers (abstract as applied to claims 4-7).

The fibers are inherently either rectangular, square, triangular, "other polygonal", circular, elliptical, and combinations of such (as applied to claim 8).

The electrode is used in a battery, the battery inherently comprises first and second electrodes with an electrolyte in ionic contact between the electrodes. The nickel-coated iron fibers incorporated into one of the electrodes (abstract as applied to claims 13 and 14).

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Additional cadmium oxide active material is provided to the sintered nickel-coated iron body having cadmium metal therein. The cadmium and cadmium oxide are introduced in a solution and the solvent is heated thereby leaving granules of the active material on and in the iron body (abstract as applied to claim 20).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 4-8, 13-14 and 20 have been considered but are moot in view of the new ground(s) of rejection.

While the majority of the prior art rejections were drawn to zinc conductive materials, JP '866 is not.

The amendment to claim 1 now excludes zinc from being the conductive material and for that reason the majority of the prior art rejections of record are withdrawn.

Yet it appears that JP '866 which discloses using cadmium metal (a species recited in claim 1) still anticipates the claims as identified above.

Therefore the prior art rejection of JP '866 stands as applied to the amended claims.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP '866.

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Claims 16-18 are drawn to product-by-process claims. Claim 18 provides structure to the claim along with process limitations. For example claim 18 to forming a fiber mat.

The teachings of claim 1, with respect to JP '866, have been discussed above and are incorporated herein.

JP '866 further forms a fiber body, i.e. a mat (abstract as applied to claim 18). The end product of JP '866 being held to be the same as that of the instant claims, regardless of the method of forming the product.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292

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(Fed. Cir. 1983). Ex parte Gray, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). See MPEP section 2113.

Claim Rejections - 35 USC § 102

9. Claims 1 and 4-14 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 856898-A2 (EP '892).

EP '892 discloses an electrode comprising a plurality of fibers and an electrically active conductive material (abstract and col. 5, line 27 through col. 6, line 13). The active conductive material is a combination of lithium with other elements (col. 5, ll. 27-43 as applied to claim 1).

The fiber diameter is 5-200 microns, which is equivalent to 0.005-0.2 mm (col. 6, ll. 1-12 as applied to claims 4-7). 200 microns being a specific value that falls within the ranges of claims 4-6 and 100 microns in the preferred diameter range being a specific value which falls within the ranges of claims 4-7.

The fibers are inherently either rectangular, square, triangular, "other polygonal", circular, elliptical, and combinations of such (as applied to claim 8).

The fibers have a length of 1-100 mm and particularly 7-30 mm (col. 6, ll. 1-12 as applied to claims 9-12). The particular range of 7-30 mm has a lower limit 7 which is a specific data point which falls in the range of each of claims 9-12.

Fig. 2 shows an electrochemical cell having first and second electrodes 8a and 8b with an electrolyte 9 in ionic contact between the electrodes. Both of the electrodes comprise fibers and active conductive material disposed on the fibers (as applied to claim 13).

The electrochemical cell is a battery cell (Title and Fig. 2 as applied to claim 14).

Response to Arguments

10. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102/103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP '898.

Claims 16-18 are drawn to product-by-process claims. Claim 18 provides structure to the claim along with process limitations. For example claim 18 to forming a fiber mat.

The teachings of claim 1, with respect to EP '898, have been discussed above and are incorporated herein.

The end product of EP '898 being held to be the same as that of the instant claims, regardless of the method of forming the product.

"[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

“The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). Ex parte Gray, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). See MPEP section 2113.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '898 in view of U.S. patent No. 6,093,503 (Isoyama).

The teachings of claim 1, with respect to EP '898 have been discussed above and are incorporated herein.

The difference between claim 15 and EP '898 is that EP '898 does not disclose the fiber material to be synthetic, cellulose or graphite fibers.

EP '898 discloses using carbon fibers (col. 6, ll. 1-3).

Isoyama is drawn to lithium electrodes wherein an active material is formed on a graphite fiber (paragraph bridging columns 1 and 2).

The motivation for using a graphite fiber is that it provides a suitable electrochemically inert, electrically conductive active material support.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of EP '898 by using a graphite fiber support as taught by Isoyama since it would have provided a suitable electrochemically inert, electrically conductive active material support. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP § 2144.07.

Response to Arguments

14. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

15. Claims 1 and 8-11, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 3,819,413 (Nippe).

Nippe discloses an electrode comprising a plurality of fibers for carrying an electrically active conductive material (abstract). The active conductive material includes iron, or iron sulfide (col. 4, ll. 44-49 prior art claim 3 as applied to claim 1).

The fibers are inherently either rectangular, square, triangular, "other polygonal", circular, elliptical, and combinations of such (as applied to claim 8).

The fibers have a length of 1 mm (col. 6, ll. 19-21 as applied to claims 9-11). 1 mm is held to be sufficiently within the range of about 2mm as recited in claims 10-11.

The electrochemical cell is a battery cell (Title and Fig. 2 as applied to claim 14).

The fibers can be graphite fibers (col. 3, ll. 33-44 as applied to claim 15).

Response to Arguments

16. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102/103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nippe.

The fibers are disposed on a substrate 51 (as applied to claim 19).

Claims 16-18 are drawn to product-by-process claims. Claim 18 provides structure to the claim along with process limitations. For example claim 18 to forming a fiber mat.

The teachings of claim 1, with respect to Nippe, have been discussed above and are incorporated herein.

The end product of Nippe being held to be the same as that of the instant claims, regardless of the method of forming the product.

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

“The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature” than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). Ex parte Gray, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989). See MPEP section 2113.

Response to Arguments

19. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. patent No. 4,169,911 (Yoshida) discloses of carbon fibers

having a thin metal conducting film such as nickel, iron, cadmium, aluminum and lithium as an electrode (abstract and col. 5, ll. 25-39). JP 2000-133245-A discloses an electrode for a battery comprising graphite fibers and an electrically active conductive material (abstract). JP 10-125348-A discloses an electrode for a battery comprising nickel fibers and an electrically active conductive material (abstract).

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (571) 272-1283. The examiner can normally be reached on Monday to Thursday from 9 a.m. to 6 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (571) 272-1292. The fax phone number for

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the organization where this application or proceeding is assigned is 703-872-9306. FAXES received after 4 p.m. will not be processed until the following business day. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregg Cantelmo
Primary Examiner
Art Unit 1745

gc



August 20, 2004